



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/722,109 | 11/25/2003 | Marc O. Schurr | 2757/101 | 4848 |
| 2101 7590 04/25/2008 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618 | | | | |
| EXAMINER | | | | |
| MATTHEWS, WILLIAM H | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3774 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/25/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,109

Applicant(s)

SCHURR, MARC O.

Examiner

William H. Matthews (Howie)

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30 and 32-36 is/are pending in the application.
4a) Of the above claim(s) 33-36 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 30, 32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's remarks with respect to claims 30 and 32 have been considered but are not persuasive.

Applicant argues the Smit device is not a rigid receptacle and teaches away from a rigid receptacle as taught by Crabb. Examiner disagrees because Smit describe the device as semi-rigid and the claims do not require a level of rigidity. Applicant points to col. 5 lines 10-14 as describing a problem potentially associated with rigid tubes however it is unclear how a rigid tube when anchored could pass out the anus. Thus the 103 combination of Smit with Crabb is not improper, and the 102 rejection in view of Smit alone appears proper.

Regarding Wilkinson, Applicant point to the characteristics of the device (durometer, flexible, and thin walled) to suggest the teachings of Crabb would change the basic principles under which Wilkinson's invention operates. Applicant's arguments suggest "rigid" requires a completely inflexible and permanent shape, thus such a modification would not operate with Wilkinson's device. Examiner disagrees because, again, Applicant's claims and specification do not describe the level of rigidity required by "rigid receptable". For example, a spaghetti noodle may be considered "rigid" or "non-rigid" depending on whether it is cooked or uncooked. However, an uncooked spaghetti noodle still possesses a level of flexibility because it may be bent. Examiner maintain rigid is a relative term and the teachings of Crabb would be combinable with

Wilkinson in an operable manner because a rigid device may possess a level of flexibility such that the device could be implanted.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 30 and 32 are rejected under 35 U.S.C. 102(b) as anticipated by Smit USPN 4315509 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smit USPN 4315509 in view of Crabb USPN 5820584. Smit disclose in figures 1-2 a synthetic stomach comprising a storage, two tubes for connection to the esophagus and small intestine, and fixing means. The device is disclosed to be designed as a semi-rigid receptacle which appears to anticipate the limitation "rigid receptacle" because the claims do not distinguish the level of rigidity. In the alternative, Crabb teach in lines 10-12 of column 2 implantable gastric devices designed to be rigid in order to provide a fixed shape. There it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device disclosed by Smit to include rigid components as taught by Crabb so that the surgeon could surgically implant the device to provide a fixed shape.

Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson USPN 5246456 in view of Crabb USPN 5820584. Wilkinson discloses in figures 1-8 a synthetic stomach comprising a storage, two tubes for connection to the esophagus and small intestine, and fixing means. The stomach storage bulges relative

to the tubes. The device disclosed by Wilkinson lack the express disclosure of the device being rigid. Crabb teach in lines 10-12 of column 2 implantable gastric devices designed to be rigid in order to provide a fixed shape. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device disclosed by Wilkinson to include rigid components as taught by Crabb so that the surgeon could surgically implant the device to provide a fixed shape.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/
Primary Examiner
Art Unit 3774